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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,433	01/16/2002	Jian Ni	PF511P1	3443

22195 7590 07/27/2004

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EXAMINER

O HARA, EILEEN B

ART UNIT PAPER NUMBER

1646

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/046,433

Applicant(s)

NI ET AL.

Examiner

Eileen O'Hara

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,10,13,16,19,20,34-38,64,65,68,71,77,80,83 and 89-159 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 104,105,107,109,111,113,115,117-130,132,133 and 140-159 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims allowed are 1,4,7,10,13,16,19,20,34-38,64,65,68,71,77,80,83,89-103,106,108,110,112,114,116,131 and 134-139.

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### **DETAILED ACTION**

1. Claims 1, 4, 7, 10, 13, 16, 19, 20, 34-38, 64, 65, 68, 71, 77, 80, 83 and 89-159 are pending in the instant application. Claims 1, 4, 7, 10, 13, 16, 19, 20, 64, 65, 68, 71, 77, 80, 83, 103 and 104 have been amended, claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 15, 17, 18, 21-33, 39-63, 66-67, 69, 70, 72, 76, 78, 79, 81, 82, 84-88 have been canceled and claims 132-159 have been amended as requested by Applicants in the Paper filed May 6, 2004.

All pending claims are currently under examination.

### ***Withdrawn Objections and Rejections***

2. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

### ***Priority***

3. Applicants traverse the priority determination at pages 16-18 of the response, and assert that the 60/144,087 application clearly and fully describes the function of the TR13 of the present invention. Applicants' arguments have been fully considered but are not deemed persuasive, for reasons of record in the previous office action mailed December 4, 2003, at pages 3-4. Applicants also submit that the allegedly contradictory statements concerning the role of TR13 antagonists and agonists in apoptosis are not found in later-filed priority applications, and recite a section from the 60/153,0978 application, which has the same disclosure as U.S. Application No. 09/618,570 and U.S. Provisional 60/261,960. Applicants assert that should the Examiner refuse to grant the earliest priority date of July 16, 1999, the instant application should in the very least be accorded the priority of the filing date of U.S. Provisional Application No.

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60/153,089. Applicants' arguments have been fully considered but are not deemed persuasive, for reasons of record in the office actions of parent application No. 09/618,570, since that application was found not to support the utility of the claimed invention.

However, upon examination of the other provisional applications, Nos. 60/148,450, 60/149,712, 60/153,089 and 60/261,960, a new effective priority date of January 17, 2001 has been accorded the instant application, since provisional application 60/261,960 filed on that date disclosed that TR13 binds FasL, which supports a specific and substantial utility of the claimed invention.

***Claim Rejections - 35 USC §§ 102 and 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

4.1 Claims 104, 105, 107, 109, 111, 113, 115, 117-124, 126-130, 132, 133 and 140-159 are rejected under 35 U.S.C. 102(a) as being anticipated by Bruck et al., WO 00/58460, October 5, 2000, for reasons of record in the previous office actions, mailed May 20, 2003, Dec. 4, 2003 and April 14, 2004. Claims 104, 105, 107, 109, 111, 113, 115, 117-124 and 126-130 were previously rejected under 35 U.S.C. 102(b), but are now rejected under 35 U.S.C. 102(a), since the effective priority date accorded the instant application is of January 17, 2001.

4.2 Claim 125 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bruck et al., WO 00/58460, October 5, 2000, in view of Fleer et al., PN 5,876,969 for reasons of record in the previous office actions, mailed May 20, 2003, Dec. 4, 2003 and April 14, 2004.

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Applicants traverse the rejections and assert that the instant application is entitled to an effective priority date of July 16, 1999 or September 10, 1999, and therefore the teaching of Bruck et al. do not qualify as prior art. Applicants' arguments have been fully considered but are not deemed persuasive, for reasons discussed *supra*. Applicants also assert that US 5,876,969 fails to disclose the TR13 molecules of the instant invention, and therefore does not itself support a rejection under 35 U.S.C. 103(a). Applicants' arguments have been fully considered but are not deemed persuasive, because the rejection was not made over US 5,876,969 alone, but in view of Bruck et al.

It is believed that all pertinent arguments have been answered.

### ***Conclusion***

5.1 Claims 1, 4, 7, 10, 13, 16, 19, 20, 34-38, 64, 65, 68, 71, 77, 80, 83, 89-103, 106, 108, 110, 112, 114, 116, 131 and 134-139 are allowed.

5.2 Claims 104, 105, 107, 109, 111, 113, 115, 117-130, 132, 133 and 140-159 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached at (571) 272-0961.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

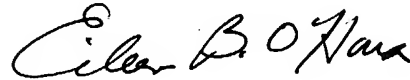
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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, se <http://pair-direct.ispto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner

A handwritten signature in cursive script that reads "Eileen B. O'Hara".

**EILEEN B. O'HARA**  
**PATENT EXAMINER**